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REMARKS

This amendment is presented in response to the office action ("office action") mailed July 19, 2006.

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35 USC 112 REJECTIONS: CLAIMS 34, 48, 63

These claims were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. As to "the method" in line 7 of claim 63, this is already sufficiently clear since it refers to "a method" in line 1. As to the remaining rejections, the claims (as amended) are sufficient under 35 USC 112.

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35 USC 103 REJECTIONS: CLAIMS 34-63

These claims were rejected under 35 USC 103 as being unpatentable over the combination of U.S. Patent No. 5,999,932 to Paul ("Paul") in view of U.S. Patent No. 6,587,550 B2 to Council et al. ("Council"). This rejection is hereby traversed. The claims are patentable since a *prima facie* case of obviousness has not been established, as discussed in greater detail below.¹

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Teaching/Suggestion of Claim Limitations

First, the *prima facie* obviousness case is incomplete because, even if the references were to be combined as suggested (albeit improperly, as discussed below), the combination still does not teach or suggest all the claim limitations.²

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as

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¹ MPEP 2142.

² MPEP 2142, 2143.03.

to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.³

All words in a claim must be considered in judging the patentability of that claim against the prior art.⁴ Taking claim 34 as an example, the proposed

5 combination of references fails to teach the following combination:

10 "A computer implemented method of operating a subscription manager to manage incoming machine readable messages arriving at a communications network having multiple remote user recipients, the method comprising the operations of:

independent of whether incoming messages have originated from a message originator pre-approved by the incoming messages' addressees, the subscription manager determining if incoming messages are subscription type messages, subscription type messages comprising recurring messages multicast to a plurality of addressees who have previously communicated to originators of the recurring messages their intent to receive such messages;

15 responsive to finding that a given message is a subscription type message, the given message having at least one addressee, performing operations comprising:

20 determining whether the given message originated from a subscription source pre-approved by the given message's addressee for sending subscribed-to messages to the given message's addressee;

25 if the given message originated from a subscription source pre-approved by the given message's addressee, forwarding the given message to the given message's addressee;

30 if the given message did not originate from a subscription source pre-approved by the given message's addressee, blocking delivery of the given message to the given message's addressee."

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Claim 34

³ *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 706.02(j).

⁴ *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

As a more particular example, claim 34 is patentably distinguished because the applied art does not show the claimed combination including "independent of whether incoming messages have originated from a message originator pre-approved by the incoming messages' addressees, the subscription manager determining if incoming messages are subscription type messages, subscription type messages comprising recurring messages multicast to a plurality of addressees who have previously communicated to originators of the recurring messages their intent to receive such messages."

The office action admitted that Paul does not teach this feature. [Office Action: page 4] Indeed, Paul does not disclose or suggest the claimed feature. Basically, Paul concerns an e-mail spam filter, which employs a user inclusion list to identify email desired by the user. If email data matches data from the user inclusion list, the email is marked "OK." If not, a heuristic process is performed to determine if the email might still be of interest to the user, in which case it marked "NEW." If the email fails the heuristic criteria, it is marked "JUNK." [Paul: Abstract]

Apart from Paul, the office action proposed that the claimed feature is found elsewhere, and particularly in Council's col. 4, lines 1-15. [Office Action: pages 4-5] The cited passage is repeated in its entirety:

Preferably, the service provided by the present invention is optional and can be enabled or disabled at the receiving party's ISP depending on whether the receiving party has subscribed to the service. FIG. 2 is a flow chart illustrating the method of the present invention in accordance with a first embodiment wherein a determination is made as to whether an e-mail message has originated from an authorized e-mail source address. The computer at the ISP decodes the datagram and obtains the source and destination addresses, as indicated at block 15. The computer then compares the source address with a list of source addresses associated with the destination address and makes a determination as to whether the source address is on a list of authorized source addresses, as indicated at block 16 and 17. Thus, the destination address is used to determine which list is associated with the intended receiving party.

The cited passage has nothing to do with the claimed feature. Although Council incidentally mentions a service that is "subscribed to," this concerns an ISP

user's subscription to an ISP service of blocking unwanted messages. Nothing in this passage teaches or suggests acts "independent of whether incoming messages have originated from a message originator pre-approved by the incoming messages' addressees." Furthermore, nothing here discloses

5 "subscription type messages."

External to the cited passage, Council's own language underscores that the disclosure is unrelated to the claimed feature. Basically, Council concerns a spam-for-cash money making scheme. Like Paul, Council uses an inclusion list to filter incoming emails. Namely, when a datagram is received at an ISP, the

10 ISP server determines whether the source address is on a list of authorized source addresses associated with the recipient. [Council: col. 2, lines 40-44] If so, the message is available to be downloaded by the recipient. If not, Council provides the sending party (i.e., the "spammer") with the option of paying a fee to have the spam delivered. [Council: col. 2, lines 45-50]

15 Despite Council's potential success in making money, there is failure in a different respect- - teaching or suggesting the claimed feature. For instance, Council does not show acts "independent of whether incoming messages have originated from a message originator pre-approved by the incoming messages' addressees" as claimed. Instead of being "independent...", Council's actions

20 specifically depend on whether incoming messages originate from a pre-approved source. Indeed, Council is specifically focused on determining whether a party sending an email communication is on a list of parties authorized by the intended receiving party. [Council: col. 2, lines 6-11]

Furthermore, Council does not teach "the subscription manager

25 determining if incoming messages are subscription type messages." Council has nothing to do with subscription messages. In fact, Council's only discussion of subscribers occurs in an unrelated context, namely, that of subscribers to an Internet Service Provider (ISP), e.g., col. 1, lines 27-67.

Moreover, Council fails to show any concern with whether messages are

30 those "multicast to a plurality of addressees who have previously communicated to originators of the recurring messages their intent to receive such messages."

Rather, Council is concerned with filtering spam, which is the opposite of user-solicited (subscription type) messages. [Council: col. 1, lines 41-50, 55-60]

Council recognizes that, with spam, the recipients of these messages often are not interested in receiving these messages. [Council: col. 1, lines 41-50]

5 cannot be said that an addressee has communicated its intent to receive a spam message. In contrast to the claimed feature, Council only cares about whether data from the incoming message matches the user's pre-approved list. [Council: Title; Abstract; col. 2, lines 6-11]

10 Accordingly, claim 34 is patentably distinguished from the proposed Paul-Council combination.

Claims 48 & 63

For similar reasons as discussed above in the context of claim 34, independent claims 48, 63 are likewise patentably distinguished from Paul-Council.

15 Furthermore, claim 63 is patentable because the office action does not specifically address the language of this claim. Particularly, pages 4-5 of the office action (where claim 63 is mentioned) are seemingly aimed at the verbiage of claim 34. However, all words in a claim must be considered in judging the
20 patentability of that claim against the prior art.⁵ Lacking this, the office action does not set forth a *prima facie* case of obviousness against claim 63.

Dependent Claims 35-47, 49-62

25 Even without considering any individual merits of dependent claims 35-47 and 49-62, these claims are distinguished from the applied art because they depend from independent claims 34 or 48, which are all distinguished as discussed above.⁶

⁵ *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 498 (CCPA 1970). MPEP 2143.03.

⁶ *Cf.* If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Nonetheless, certain features of these dependent claims are noted to further distinguish over the applied art, as explained below.

Claims 35, 49

- 5 As to claims 35 and 49, the applied art does not teach "responsive to determining that a given message is not a subscription type message, forwarding the given message to its addressee." The office action proposed that this feature is found in Paul's disclosure, at col. 7, lines 26-40. [Office Action: page 5] Yet, Paul's own words show that Paul does not care whether a given message is a
- 10 subscription type message or not. Second, Paul does not forward a given message to its address on the basis that the message is not a subscription type message. Accordingly, claims 35/49 are *a fortiori* distinguished from Paul.

Claims 37, 51

- 15 Claims 37 and 51 are further defined over Paul because Paul does not teach "presenting to the given message's addressee an offer of a subscription to a machine-automated service of providing messages related to the given message, and only upon receiving acceptance of the offer, performing operations of: forwarding the given message to the addressee; precompleting a subscription
- 20 activation form and providing the precompleted form to the addressee; responsive to the addressee's acceptance of the form, on behalf of the addressee obtaining from a source of the given message a subscription to a machine-automated service providing future messages relating to the given message."
- 25 The office action suggests that such features can be found in Paul's column 6, lines 20-40. [Office Action: pages 5-6] The cited passage, however, merely discusses Paul's addition of new data to the user inclusion list as incoming email is processed. For example, if an email's subject field matches the "subject" field in the user's inclusion list, then Paul automatically adds the
- 30 "from" and "to" data from the email into the user's inclusion list.

In contrast, Paul has nothing to do with users' subscribing to electronically generated messages. Paul concerns the opposite, namely, processing incoming messages to filter unsolicited email. [Paul: Abstract; col. 1, line 66 – col. 2, line 63] Thus, Paul is devoid of operations such as "precompleting a subscription
5 activation form and providing the precompleted form to the addressee" and "responsive to the addressee's acceptance of the form, on behalf of the addressee obtaining from a source of the given message a subscription to a machine-automated service providing future messages relating to the given message." Clearly, Paul does not communicate with the source of a given
10 message to obtain a subscription to messages. Rather, Paul's focus is on junk email, which is unsolicited. [Paul: column 1, lines 23-43] Accordingly, claims 37 and 51 are patentably distinguished from Paul.

Claims 38, 52

15 Claims 38 and 52 are further defined over Paul because Paul does not teach "the subscription manager is operated remotely by a communications service provider on behalf of the user recipients; the operation of blocking delivery of the given message further comprises, only if the given message includes evidence that the given message originated from a recognized business
20 partner of the service provider, presenting the addressee with at least one of the following user-activated options: (1) to receive the message, (2) to obtain from a source of the given message a subscription to a machine-automated service providing future messages relating to the given message."

In one embodiment of Paul purportedly, filtering is purportedly performed
25 at a central location for all users within a network such as a LAN. [Paul: col. 6, line 67 – col. 7, line 14] Nevertheless, Paul does not teach a subscription manager operated by a service provider on behalf of multiple user recipients, and a recognized business partner of the first entity. Accordingly, Paul is not concerned with whether a given message "originated from a recognized business
30 partner of the service provider..." as claimed. Rather, Paul's sole criteria for filtering incoming emails is a user inclusion (or exclusion) list. Moreover, as

Paul's disclosure is directed at filtering spam, it is clear that Paul would never obtain from a spammer "...a subscription to a machine-automated service providing future messages relating to the given message."

Accordingly, claims 38 and 52 are *a fortiori* distinguished from Paul.

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Claims 39, 53

Claims 39 and 53 are defined over Paul for similar reasons, and in addition, because Paul does not teach the claimed operations where:

10 "subscription manager is operated remotely by a communications service provider on behalf of the user recipients; the operations further comprise, apart from messages directed to the user recipients, the service provider receiving from recognized business affiliates of the service provider indicia identifying subscription type messages originating from said business affiliates; the operation of determining if incoming messages are subscription type messages
15 comprises examining incoming messages for said indicia.

In contrast, Paul does not teach a subscription manager operated by a communications service provider having recognized business affiliates. In this regard, Paul is devoid of any discussion of business partners, affiliates, associates, etc. Moreover, Paul does not show a subscription manager receiving
20 (apart from messages directed to the user recipients) indicia from recognized business affiliates identifying subscription type messages originating from those affiliates. In contrast, Paul's sole criteria for filtering incoming emails is a user inclusion (or exclusion) list as discussed above. In this regard, Paul's system can be implemented on a user terminal system with a user interface such as
25 MICROSOFT OUTLOOK. [Paul: column 3, lines 36-54] Paul is therefore unconcerned with any service provider, and further lacks any teaching regarding business affiliates of the service provider, and still further lacks an operation where the service provider receives information directly from business affiliates that is used to process incoming messages.

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Accordingly, Claims 39 and 53 are patentably distinguished on their own merits, beyond the fact that they are patentable due to dependence on allowable base claims 34 and 48.

5 Claims 40, 54

Claims 40 and 54 are further defined over Paul for various reasons. For example, Paul does not contemplate "business affiliates of the service provider" as claimed. Although Paul purports to show an automatically generated inclusion list, this list is generated based upon email fields such as TO, FROM, CC, BCC, and SUBJECT, etc. [Paul: col. 4, lines 34-40] The user inclusion list is said to be created by gathering information from various sources such as user inbox, user outbox, user address book, user buddy list, personal manager, etc. [Paul: col. 4, lines 41-50; Fig. 2] Paul fails to discuss an operation such as "maintaining a record of machine-readable identifying indicia provided by business affiliates of the service provider and serving to uniquely identify each said business affiliate" as claimed. Accordingly, claims 40 and 54 are further distinguished over the applied art.

20 Claims 42, 56

Claims 42 and 56 are further defined over Paul because Paul does not teach "the operation of, if the given message originated from a subscription source pre-approved by the given message's addressee, forwarding the given message to the addressee further comprises: determining which of the following that the given message pertains to: subscription maintenance or subscription content; making a different presentation of the given message to the addressee depending on whether the message pertains to subscription content or subscription maintenance."

The office action suggested that such features are found in Paul's column 6, lines 20-40. [Office Action: page 8] However, as discussed above, this passage merely discusses Paul's addition of new data to the user inclusion list as incoming email is processed. Since Paul does not address subscription type

messages at all, Paul clearly fails to distinguish between "subscription maintenance" and "subscription content" as required by the claims. Further, Paul does not show "making a different presentation of the given message to the addressee" on such basis. Accordingly, claims 42 and 56 are patentably
5 distinguished from Paul.

Claims 43-44, 57-58

Claims 43-44 and 57-58 are distinguished over Paul for similar reasons as claims 42 and 56, and additionally because Paul does not teach any
10 communications with the sources of received messages. Rather, Paul's approach is simply to filter incoming messages. [Paul: Title; Abstract] In all cases, Paul's disclosure teaches away from communicating with the source of received messages. It is widely known that communicating with a junk email sender (such as by indicating a request to stop the junk email) is ineffective, and
15 worse yet, may result in validation of the recipient's email address to the junk email sender, encouraging the proliferation of junk email. Therefore, Paul teaches away from any communications with the sources of unsolicited email messages.

Relatedly, in the case of claims 43 and 57, Paul further lacks a user-
20 activated cancellation message. Nor does Paul teach the negotiation of subscription cancellation with the subscription source free of further input by the given message's addressee. In the case of claims 44/58, Paul further fails to teach negotiating activation of the subscription with the subscription source. Accordingly, claims 43-44 and 57-58 are patentably distinguished over Paul on
25 their own merits, beyond their allowability by virtue of their dependence on allowable base claims 34 and 48.

Claim 62

Claim 62 is patentable because the office action does not specifically
30 address the language of this claim. Particularly, page 6 of the office action (where claim 62 is discussed) seem to be aimed at the verbiage of claim 38.

However, all words in a claim must be considered in judging the patentability of that claim against the prior art.⁷ Lacking this, the office action fails to set forth a *prima facie* case of obviousness against claim 62.

5 Suggestion or Motivation

In addition to the reasons given above, the *prima facie* obviousness case is also defective because there has been no suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference
10 teachings.⁸

The office action proposes that it would have been obvious to one of ordinary skill in the art to modify the invention of Paul using the teaching of the service provider as taught by Council. [Office Action: page 5] The rationale for making this modification is that such modification would "enable the system to
15 determine if incoming messages are subscription type messages so that the user would read the authorized messages." [Office Action: page 5]

The rationale proposed in the office action is inadequate for a number of reasons. First, simply stated, this rationale does not make sense. As discussed above, Paul and Council do not show any recognition or concern whatsoever
20 with subscription type messages. The proposed benefit of determining if incoming messages are subscription type messages is wholly lacking since Paul/Council are clearly not concerned with subscription type messages. Without any need for the proposed benefit, there would be no reason to combine Paul and Council.

25 Second, the rationale for combining Paul and Council is also inadequate because, according to their own disclosures, Paul and Council already include measures so that "the user would read the authorized messages." With Paul, one stated object is to eliminate unwanted email messages. [Paul: col. 1, line 66]

⁷ *In re Wilson*, 424 F.2d 1382, 185 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

⁸ MPEP 2142.

– col. 2, line 2] With this approach, namely by eliminating unwanted email messages, users would be able to read authorized messages. With Council, a specific goal is determining whether email has been sent by a party that is authorized to communicate with the intended recipient. [Council: col. 1, lines 16-24] As with Paul's approach, Council's approach purportedly enables users to read authorized messages. Both Paul and Council, therefore, already seem to include means for so that the user would read authorized messages. Since each reference alone already claims to achieve the office action's proposed goal, this goal does not provide any reason to combine Paul and Council.

Third, the rationale for combining Paul and Council is insufficient because the proposed modification of Paul by adding Council would render Paul unsatisfactory for its intended purposes.⁹ A stated purpose of Paul is to eliminate unwanted email messages. [Paul: col. 1, line 66 – col. 2, line 2] In this regard, Paul is said to filter unsolicited email using data matching and heuristic processing. [Paul: Title; Abstract] Although Council shows some attention to whether email has been sent by an authorized sending party, Council expressly permits delivery of messages that Paul would otherwise block, whenever the sender pays a fee. [Council: ref. 19-23, Fig. 2; ref. 33-39, Fig. 3] Therefore, Council would render Paul unsatisfactory for its stated purpose of eliminating unwanted email messages, because Council would actually increase the number of unwanted email messages delivered by Paul. The argument for combining Paul and Council is therefore untenable.

Reasonable Expectation of Success

In addition to the reasons stated above, the *prima facie* obviousness case is further defective because the office action failed to show that there would be a reasonable expectation of success in modifying/combining references.¹⁰ The examiner bears the initial burden of factually supporting any *prima facie*

⁹ *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01.

¹⁰ MPEP 2142, 2143.02.

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conclusion of obviousness.¹¹ If the examiner does not produce a *prima facie* case, the applicant is under *no* obligation to submit evidence of nonobviousness.¹² Critically, to establish a *prima facie* case of obviousness, *there must be a reasonable expectation of success*.¹³ This reasonable
5 expectation of success must be found in the prior art, not in Applicant's disclosure.¹⁴

The office action lacks any evidence, allegation, or mere mention of the legally required "reasonable expectation of success." Since this mandatory topic is unaddressed by the office action, no *prima facie* case of obviousness has been
10 properly established.

Summary as to Rejections Under 35 USC 103

As shown above, then, these claims are patentable since a *prima facie* case of obviousness does not exist. Namely, (1) the applied art fails to teach the
15 features of the claims, (2) there is insufficient motivation to combine/modify references as proposed by the office action, and (3) there is no showing that an ordinarily skilled artisan would have a reasonable expectation of success in making the office action's proposed modification of references.

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CONCLUSION

In view of the foregoing, all pending claims in the application are patentable over the applied art. Favorable reconsideration and allowance of the application are hereby requested.

If any fees are required by this submission, an appropriate fee submittal
25 sheet is enclosed herewith. If fees are required yet this sheet is inadvertently

11 MPEP 2142.

12 *Id.*


13 MPEP 2143.

14 *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). MPEP 2143.

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Respectfully Submitted,



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